

Applicant: Boney A. Mathew
Serial No.: 10/603,549
Amendment dated April 18, 2005
Reply to Office Communication dated March 17 2005

REMARKS

Claims 1, 2, 4 and 7-22 remain in the application where only claim 1 be independent. After entry of the present amendment in reply to this Office Communication claims 1, 2, 4 and 7-22 will be pending in the application. Claims 1, 4, and 7 have been amended to more clearly define the invention as originally claimed.

Specification

The specification was objected to under 35 U.S.C. § 132 due to introduction of a new matter into the disclosure. The specification has been amended to merely clarify the embodiments described therein and to render this objection moot.

Claim Rejection – 35 U.S.C. § 112

Claims 1, 2, 4, and 7 through 22 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The specification, as amended by the Applicant, renders this rejection moot. As amended, the independent claim 1 is supported by paragraphs [00025] and [00026] of the specification, as originally filed by the Applicant.

Claim Rejection – 35 U.S.C. § 103

Claims 1, 2, 4, and 7 through 22 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over the United States Patent No. 5,200,252 to Kelman (the '252 Patent) in view of the United States Patent No. 4,536,116 to Murray (the '116 Patent).

2143.03 All Claim Limitations Must Be Taught or Suggested

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If

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an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

2142 Legal Concept of *Prima Facie* Obviousness

...The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness...

ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP §2143-§2143.03 for decisions pertinent to each of these criteria. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The '252 Patent teaches a method of making a molded plastic part wherein apre-formed outer skin **14** is placed a mold cavity and a foaming resin is poured in the mold cavity to be integrally molded with the outer skin **14**. The outer skin **14** is co-molded to a surface **16** of a foam layer **12**. The foam layer **12** preferably comprises a low density mat formed by a matrix of reinforcing material such as woven fiberglass **28** molded within a thermoset foam resin.

The '252 Patent does not teach or suggest injecting an insulating layer composition of *an expanded compressible polymer* around an insert followed by injecting

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a part composition over the bottom and the sides of the insulating layer to expose the open top to completely isolate the insert from the part whereby *the insulating layer adapts to differences in thermal expansion between the insert and the part.*

Similarly, the '116 Patent teaches a part **20A** having a metal insert **10** and a plastic insert **50**. The plastic insert **50** and the metal insert **10** engaged therein are placed into a cavity **38** defined between mold plates **40, 42** wherein a plastic material is introduced to form the part **20A**. The plastic material partially encapsulates the metal insert **10** and the plastic insert **50** leaving gaps defined between the metal insert **10** and the plastic insert **50**. The plastic insert **50** is formed of high density polypropylene material. The '116 Patent teaches the plastic insert formed of the material having rigid structure is not movable or compressible like a natural rubber.

The Murray Patent does not teach or suggest injecting an insulating layer composition of *an expanded compressible polymer* around an insert followed by injecting a part composition over the bottom and the sides of the insulating layer to expose the open top to completely isolate the insert from the part whereby *the insulating layer adapts to differences in thermal expansion between the insert and the part.*

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation in the prior art references to modify the reference or to combine reference teachings or the prior art reference (or references when combined) must teach or suggest all the claim limitations. There is no teaching, motivation, or suggestion in the '252 Patent to apply the teachings of the '116 Patent to arrive at the Applicant's invention. None of the aforementioned patents teaches or suggest "*injecting an insulating layer composition of an expanded compressible polymer around an insert followed by injecting a part composition over the bottom and the sides of the insulating layer to expose the open top to completely isolate the insert from the part whereby the insulating layer adapts to differences in thermal expansion between the insert and the*

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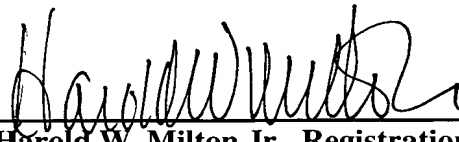
part", wherein the expanded compressible polymer has characteristics of a natural rubber to accommodate the differences between the coefficients of thermal expansion thereby eliminating problems of potential cracks, sink-marks, and the like, in a plastic surrounding the insulating layer. Adding the foam layer **12** reinforced by woven fiberglass **28** molded within a thermoset foam resin, as taught by the '252 Patent, partially and around the plastic insert **50** of the '116 Patent, without completely isolating the plastic insert **50**, will **teach away** from the Applicant's invention and will not eliminate the aforementioned problems.

For these reasons, Applicant respectfully submits that independent claim 1 and dependent claims 2, 4, and 7 through 22, dependent on independent claim 1, are in condition for allowance.

Accordingly, it is respectfully submitted that the Application, as amended, is now presented in condition for allowance, which allowance is respectfully solicited. Further and favorable reconsideration of the outstanding Office Action is hereby requested.

Respectfully submitted

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CERTIFICATE OF MAILING

I hereby certify that this **Amendment** for U.S. Serial No.: 10/603,549 filed June 25, 2003 is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, MAILSTOP AMENDMENT, P.O. Box 1450, Alexandria, Virginia 22313-1450, on **April 22, 2005**.

Melissa Dadisman
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